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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,671	12/24/2003	Kia Silverbrook	NPB008US	7891
24011	7590	01/27/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD				YOUNG, JOHN L
393 DARLING STREET				ART UNIT
BALMAIN, 2041				PAPER NUMBER
AUSTRALIA				3622

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	SILVERBROOK ET AL.
Examiner John L Young	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 24 December 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

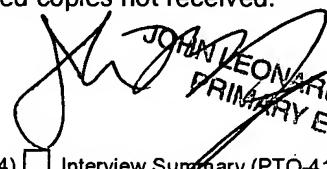
### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



JOHN LEONARD PRINNYARD YOUNG, ESQ.  
PRINCIPAL EXAMINER

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/24/2005.

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## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS – 35 U.S.C. §112 ¶2**

35 U.S.C. §112 ¶2 reads as follows:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as [his/her] invention.

2. Claims 2-4, & 9-11 are rejected under 35 U.S.C. §112 ¶2, as being indefinite because said claims recite improper Markush Group claim language. For example, said claims at line 1, recite “the group comprising. . .” and should recite “the group consisting. . .”

### **CLAIM REJECTION – 35 U.S.C. §103( a )**

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The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Beck 6,230,197 (05/08/2001 [US f/d: 09/11/1998] (herein referred to as “Beck”).

As per claim 1, Beck (FIG. 8 in general and FIG. 8, el. 227 & el. 233) discloses: “*Fax Text. . .*” and depictions of fax machines with text being scanned in. The Examiner interprets this disclosure as showing “an input element of a printed publication using a sensing device and a computer . . . the sensing device being adapted to sense at least some of the coded data when placed in an operative position relative to the printed publication and to generate indicating data using at least some of the sensed coded data, the indicating data being indicative of at least one of a position and a movement of the sensing device relative to the printed publication, the method comprising the steps of, in the computer receiving the indicating data from the sensing device and

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identifying, form the indicating data and the electronic description, whether the user has selected the input element using the sensing device and, if so, notifying the associated entity of the selection. . . .”

Beck (FIG. 3; FIG. 9; and col. 9, ll. 25-40) discloses: “*The text version of an event must be machine-readable and human readable. . . .*”

Beck (FIG. 3; FIG. 9; col. 4, ll. 6-15; and col. 9, ll. 25-40) shows: “A method of tracking user interaction with an input element of a printed publication using sensing device and a computer. . . .”

Beck lacks an explicit showing of “the printed publication having disposed therein or thereon human-readable information and machine-readable coded data, the human-readable information being indicative, to a user, of the input element, portions of the machine-readable coded data being indicative of their own position relative to the printed publication, the computer system storing an electronic description of the printed publication and an association between the input element and an associated entity. . . .”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Beck at least at (FIG. 3; FIG. 9; and col. 9, ll. 25-40 as well as Beck (the ABSTRACT; FIG. 8 in general and FIG. 8, el. 227 & el. 233; col. 4, ll. 6-15; col. 4, ll. 16-67; col. 5, ll. 1-55; col. 6, ll. 20-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; 15, ll. 1-67; col. 16, ll. 1-67; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-

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67; col. 22, ll. 1-67; col. 23, ll. 1-67; col. 24, ll. 1-67; col. 25, ll. 1-20; and whole document) implicitly shows: “the printed publication having disposed therein or thereon human-readable information and machine-readable coded data, the human-readable information being indicative, to a user, of the input element, portions of the machine-readable coded data being indicative of their own position relative to the printed publication, the computer system storing an electronic description of the printed publication and an association between the input element and an associated entity. . . .” and it would have been obvious to modify and interpret the disclosure of Beck cited above as implicitly showing “the printed publication having disposed therein or thereon human-readable information and machine-readable coded data, the human-readable information being indicative, to a user, of the input element, portions of the machine-readable coded data being indicative of their own position relative to the printed publication, the computer system storing an electronic description of the printed publication and an association between the input element and an associated entity. . . .” because modification and interpretation of the cited disclosure of Beck would have provided means for “*a data extraction facility for deriving information from text files, including the text versions of non-text files. . . .*” (see Beck (col. 4, ll. 55-65)), based on the motivation to modify Beck so as to allow files to be “*accessed by the interactive display interface along with the recorded events and text versions of recorded events. . . .*” (see Beck (col. 4, ll. 65-67)).

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Claim 2 is rejected for at least substantially the same reasons as claim 1. (See Beck (col. 23, ll. 55-65) which discloses a “*manufacturer*. . . .” The Examiner interprets this disclosure as showing a “*merchant*. . . .”

Claim 3 is rejected for at least substantially the same reasons as claim 1.

Claim 4 is rejected for at least substantially the same reasons as claim 1 and claim 2.

As per claim 5, Beck shows the method of claim 1:

Beck (FIG. 8 in general and FIG. 8, el. 227 & el. 233) discloses: “*Fax Text. . . .*” and depictions of fax machines with text being scanned in. The Examiner interprets this disclosure as showing “wherein the printed publication comprises a plurality of pages. . . .”

Beck (the ABSTRACT; col. 4, ll. 48-67; and col. 5, ll. 10-36) discloses: “*storing copies of transactions . . . relating to the transactions according to specific criteria, and an interactive interface for a user to access the files for a graphic string of identifiers representing the files. . . .*”

Beck (col. 24, ll. 9-65) discloses: “*the media type of the interaction is identified. . . . If the media type is . . . text-based . . . then the interaction is prepared for entry into a database. . . . Preparation may include such automated processes as scanning . . . file conversions, and so on.*”

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Beck lacks an explicit showing of “wherein the coded data is further indicative of an identity of the page of the printed publication that the coded data is disposed in or on. . .”

“Official Notice” is taken that both the concepts and the advantages of “wherein the coded data is further indicative of an identity of the page of the printed publication that the coded data is disposed in or on. . .”, were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art to interpret and modify the disclosure of Beck cited above as implicitly showing “wherein the coded data is further indicative of an identity of the page of the printed publication that the coded data is disposed in or on. . .” because modification and interpretation of the cited disclosure of Beck would have provided means for “*a data extraction facility for deriving information from text files, including the text versions of non-text files. . .*” (see Beck (col. 4, ll. 55-65)), based on the motivation to modify Beck so as to allow files to be “*accessed by the interactive display interface along with the recorded events and text versions of recorded events. . .*” (see Beck (col. 4, ll. 65-67)).

As per claim 6, Beck shows the method of claim 5.

Beck lacks an explicit showing of “calculating a payment associated with the selection of the input element. . .”

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“Official Notice” is taken that both the concepts and the advantages of “calculating a payment associated with the selection of the input element. . . .”, were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art to interpret and modify the disclosure of Beck cited above as implicitly showing “calculating a payment associated with the selection of the input element. . . .” because modification and interpretation of the cited disclosure of Beck would have provided means for “*a data extraction facility for deriving information from text files, including the text versions of non-text files. . . .*” (see Beck (col. 4, ll. 55-65)), based on the motivation to modify Beck so as to allow files to be “*accessed by the interactive display interface along with the recorded events and text versions of recorded events. . . .*” (see Beck (col. 4, ll. 65-67)).

As per claim 7, Beck shows the method of claim 6.

Beck lacks an explicit showing of “notifying the associated entity of the payment associated with the selection of the input element. . . .”

“Official Notice” is taken that both the concepts and the advantages of “notifying the associated entity of the payment associated with the selection of the input element. . . .”, were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art to interpret and modify the disclosure of Beck cited above as implicitly showing

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“notifying the associated entity of the payment associated with the selection of the input element. . . .” because modification and interpretation of the cited disclosure of Beck would have provided means for “*a data extraction facility for deriving information from text files, including the text versions of non-text files. . . .*” (see Beck (col. 4, ll. 55-65)), based on the motivation to modify Beck so as to allow files to be “*accessed by the interactive display interface along with the recorded events and text versions of recorded events. . . .*” (see Beck (col. 4, ll. 65-67)).

Claim 8 is rejected for at least substantially the same reasons as claim 1.

Claim 9 is rejected for at least substantially the same reasons as claim 2.

Claim 10 is rejected for at least substantially the same reasons as claim 3.

Claim 11 is rejected for at least substantially the same reasons as claim 4.

Claim 12 is rejected for at least substantially the same reasons as claim 5.

Claim 13 is rejected for at least substantially the same reasons as claim 6.

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Claim 14 is rejected for at least substantially the same reasons as claim 7.

## **CONCLUSION**

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or (703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

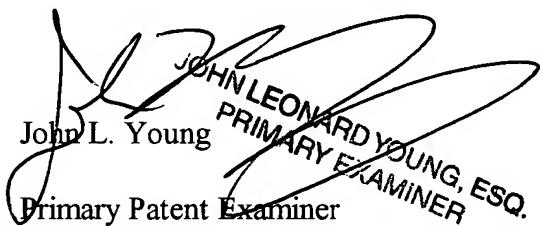
Seventh floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801 or (571) 272-6725. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469 or (571) 272-6724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young  
Primary Patent Examiner  
JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

January 24, 2005